

REMARKS

The applicant notes with appreciation the Examiner's comments in the Office Action dated December 29, 2005, in particular the substantive allowance of claims 3, 6, 7, 8, 10, 15, and 16. It is noted that the Examiner withdraws the previous rejections of record, and makes new rejections based on newly cited art. It is believed that the present amendments and arguments overcome the new rejections presented. Accordingly, withdrawal of the claims rejections and allowance of the application is respectfully requested.

Amended claim 1 is presented herewith to more clearly distinguish the features of the present invention from the art cited by the Examiner. Specifically, claim 1 is amended to recite a grip for sporting equipment, wherein the base layer of the grip of the present invention overlays the gripping end. This limitation was previously present in claim 1 as originally filed. For additional support for the amendment, reference is made to Figure 2, clearly showing a base layer 12 overlaying a gripping end 19 of an item of sports equipment. Still further, reference is made in the Specification (see the final partial paragraph of the amended Specification on page 9, bridging to page 10), which recites “. . . a grip 10 may include a base layer 12 which may be a hollow sleeve adapted to engagingly receive the gripping end in an interior 14 thereof. The base layer 12 may also be a planar sheet for encircling the gripping end as shown in Figure 5. . .”

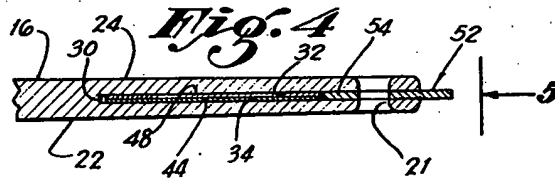
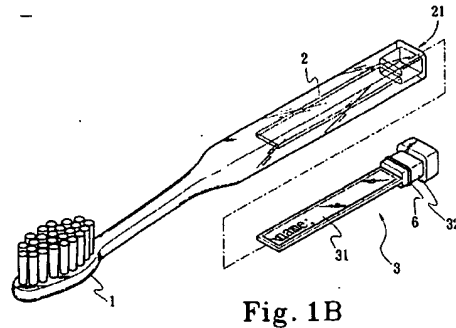
The feature of a base layer overlaying a gripping end is clearly shown in the Figures and described in the Specification, and was recited in the claims as filed. For

these reasons, it is believed that the amendment to claim 1 presents no new matter. Further, since the feature was recited in original claim 1, it is also believed that the feature should have been adequately searched, and that no new search is necessary. As will be discussed below, it is believed that this amendment overcomes the rejections made based on the new art cited by the Examiner.

In paragraph 2, the Examiner rejects claims 1, 2, 9, 12-14, and 17-19 under 35 U.S.C. §102(b) as anticipated by U.S. Published Patent Application No. 2004/0139569 to Chen. In paragraph 7, claims 1, 2, 9, 12, and 17-19 are rejected under Section 102(b) over U.S. Patent No. 2,489,707 to Eubanks. However, it is believed that after reviewing the amendments and arguments presented herein, the Examiner will agree that Chen and Eubanks simply do not teach the claimed combinations of the present invention with the requisite specificity to support an anticipation rejection. Accordingly, withdrawal of the rejection of these claims over the Chen and Eubanks references is respectfully requested.

The Examiner states in paragraph 2 that Chen teaches a grip comprising a base layer (column member 3), a substantially transparent top layer (handle 2) overlaying the base layer, and a design layer (label 31) positioned between handle 2 and column member 3). In paragraph 7, the Examiner states that Eubanks teaches a grip comprising a base layer (card 44), a substantially transparent top layer (exterior surfaces 22 and 24) overlaying the base layer, and a design layer 48 positioned therebetween. Accordingly, the features disclosed in these references, and described by the Examiner as base layers (column member 3 of Chen, card 44 of Eubanks), do not and cannot overlay a gripping

end, or any other feature of the inventions of Chen and Eubanks. This is because for each feature (see Figure 1B of Chen and Figure 4 of Eubanks, reproduced below for the Examiner's convenience), the structures described as base layers are the center-most structures of the disclosed devices, and do not overlay any other structure.



In contrast, for the grip (claim 1) and method for displaying a design (claim 17) of the present invention, the Specification clearly discloses (see, for example, Figure 2 of the present application and the discussion *supra*) and the claims clearly recite the feature of a base layer overlaying the gripping end of an item of sports equipment. Unlike the devices of Chen and Eubanks, wherein the features identified by the Examiner as base layers are the center-most structures of the devices, the base layer of the present invention indeed overlays the gripping end. Accordingly, the Chen and Eubanks references simply do not

teach the features of the present invention with the requisite specificity to support an anticipation rejection of independent claims 1 and 17 under 35 U.S.C. § 102.¹ It is therefore respectfully submitted that allowance of amended claim 1 and claim 17 is appropriate in the present case. With regard to the rejection of claims 2-3, 12-14, and 17-19 (paragraphs 4-9 of the Office Action) over Chen and Eubanks, these dependent claims import all of the limitations of the independent claims from which they respectively depend (claims 1 and 17). Accordingly, it is believed that because the dependent claims of this application depend respectively from what are believed to be allowable independent claims 1 and 17, they are not anticipated and should also be in condition for allowance.

The Examiner also rejects claims 4-5 under 35 USC §103(a) as rendered obvious by the Chen reference, stating that since the Applicant allegedly failed to disclose any particular purpose or problem solved by the feature of a base layer configured as a contiguous hollow sleeve, the “solid cylindrical base layer as taught by Chen would perform equally well.” However, as discussed above it is believed that amended claim 1 is now placed in condition for allowance. Of course, under the teachings of *In re Fine* the claims depending from claim 1, including claims 4-5, are also believed to be in condition for allowance.² It is further noted that amended claim 1 includes the feature of a base layer overlaying a gripping end. Replacing the base layer of the present invention with

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001).

² *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

the solid cylindrical structure of Chen (Figures 5A-B) would therefore render the present invention inoperative. Withdrawal of the rejection is respectfully requested.

It is now believed that the claims of the present application have been placed in condition for allowance. Accordingly, issuance of an early Notice of Allowance is respectfully requested. If any issues remain, however, the Examiner is respectfully requested to contact the Applicants' attorney at the telephone number of record in order to expedite the prosecution of this patent application.

Respectfully submitted,

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